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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,033	03/27/2001	Akio Ishikawa	010430	7311

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EXAMINER

HAQ, NAEEM U

ART UNIT PAPER NUMBER

3625

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/817,033

Applicant(s)

ISHIKAWA ET AL.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-5 is/are allowed.
- 6) ☒ Claim(s) 1 and 6-8 is/are rejected.
- 7) ☒ Claim(s) 2-5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to the Applicants' amendment filed on October 26, 2004. Claims 1-8 are pending and will be considered for examination. Applicants' amendment to claim 1 is sufficient to overcome the objection to claims 1-6. This objection is hereby withdrawn. Applicants' amendment to claim 2 is sufficient to overcome the 112, second paragraph rejection of claims 2-5. This rejection is hereby withdrawn.

### ***Allowable Subject Matter***

Claims 2-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 2 recites the patentably distinct feature that the bid evaluation function is based on the combination of past bidding prices per unit volume and on the efficiency of utilization of resources won in the past. The Prior art of record does not disclose or suggest this feature.

### ***Final Rejection***

#### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Fisher et al. (US 5,835,896).**

Referring to claims 1, 7, and 8, Fisher teaches a method of competitive buying and selling comprising: a first step in which a server opens a subject of buying and selling and a successful bid evaluation function thereof to a plurality of clients (column 6, line 4 – column 7, line 40; Figure 1); a second step in which each of said clients makes a participant determine said subject of buying and selling and a bidding price thereof by using said successful bid evaluation function, and notifies a determined result to said server (column 7, line 24 – column 8, line 14); and a third step in which said server select a bidding price of a participant who has indicated a highest evaluation value based on said successful bid evaluation function among all bidding prices notified from the clients and designates the participant as a successful bidder (column 10, lines 6-28).

Referring to claim 6, Fisher teaches that the method is applied to a competitive bidding method (Abstract).

### ***Response to Arguments***

Applicants' arguments regarding the rejection of claims 1 and 6-8 under 35 U.S.C. 102 have been fully considered but they are not persuasive. The Applicants have argued that the Examiner has not given sufficient weight to the term "bid evaluation function". The Examiner respectfully disagrees. The Examiner notes that the term "bid evaluation function" is a term that the

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Applicants created to describe their invention. Therefore the Applicants are responsible for defining this term.

An applicant is entitled to be his or her own lexicographer, and in any instances will provide an explicit definition for certain terms used in the claims. Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro C. v. White Consolidated Industries Inc.* 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed Cir. 1999). Inventor may define specific terms used to describe invention, but must do so with reasonable clarity, deliberateness, and precision. *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (fed. Cir. 1992)).

In the present case, the Applicants' specification does not provide an explicit definition for the term "bid evaluation function" but instead provides an example (see specification page 13, lines 17 and 18). Therefore the term "bid evaluation function" is given the broadest reasonable interpretation in light of the specification and limitations in the specification will not be read into the claim language. The Applicants have also argued that the term "bid evaluation function" implies the use of a mathematical operation on the bid, and that Fisher's bid validator does not disclose or suggest a mathematical evaluation. The Examiner disagrees. Fisher teaches that bids must meet a bid increment

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amount. Fisher also teaches that the bid validator verifies that an appropriate bid amount has been entered (column 7, lines 57-63). Therefore Fisher's bid validator is performing a mathematical function by verifying that the bid meets the bid increment amount. For this reason, the Examiner maintains the art rejection.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (703)-308-1344.

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Naeem Haq**, Patent Examiner  
Art Unit 3625

January 7, 2005



WYNN W. COGGINS  
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